

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF WISCONSIN

E-IMAGEDATA CORP.,
Plaintiff,

v.

Case No. 2:16-cv-576

DIGITAL CHECK CORP.
d/b/a ST IMAGING,
Defendant.

COMPLAINT

Under the Court's April 29, 2016 Order (Dkt. 45) in Case No. 15-cv-00658, which severed Counts IV through VI from e-Image's Second Amended Complaint (Dkt. 29) against ST Imaging, e-Image re-files its claims and alleges as follows:

NATURE OF THIS ACTION

1. This action involves a request for a permanent injunction and monetary damages stemming from ST Imaging's infringement of U.S. Patent Nos. 8,537,279; 9,179,019; and 9,197,766.

PARTIES

2. Plaintiff e-ImageData Corp. is a Wisconsin corporation with its principal place of business located at 340 Grant Street, Hartford, Wisconsin. Plaintiff e-Image is a manufacturer of digital microfilm scanning systems.

3. Defendant Digital Check Corp. is a Delaware Corporation that is qualified to do business in Illinois. Its principal place of business is located at 630 Dundee Road, Suite 210, Northbrook, IL 60062. Digital Check Corp. has a division that does business under the trade name ST Imaging. ST Imaging is a direct competitor of e-Image in the field of digital microfilm scanning systems.

JURISDICTION

4. This is an action for patent infringement arising under the patent laws of the United States, 35 U.S.C. § 1, *et seq.* The Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331, 1332, 1338, and 15 U.S.C. § 1121.

5. This Court has supplemental jurisdiction over all state law and common law claims under 28 U.S.C. § 1367(a).

6. This Court has personal jurisdiction over Defendant under 28 U.S.C. § 1400 and Wis. Stat. § 801.05. ST Imaging promotes, distributes, sells and offers to sell products in this District including digital microfilm scanners. ST Imaging has purposefully availed itself of the privileges and benefits of the laws of the State of Wisconsin, and through the promotion, selling or offering to sell the ViewScan microfilm scanners, has committed acts of patent infringement during the course of their business in this district.

7. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391 and 1400.

BACKGROUND REGARDING THE PRODUCTS AND THE PARTIES

8. Since February 2003, e-Image has been selling its line of ScanPro products, which are integrated, desktop microfilm readers designed for public use. The machines are used primarily by libraries, universities, and researchers to allow microfilm to be converted to electronic images that can be edited using digital editing techniques, printed, e-mailed, or saved to other media such as CD-ROMs, flash drives, and hard drives.

9. ST Imaging sells a line of microfilm scanners known as the ST ViewScan, ST ViewScan II, ST ViewScan III, and ST ViewScan III-B (collectively the “ViewScan Products”).

10. ST Imaging’s ViewScan Products directly compete in the market with e-Image’s ScanPro product line.

11. The combined sales of microfilm scanners sold by e-Image and ST Imaging make up the majority of the market for microfilm scanners.

ST IMAGING'S PATENT INFRINGEMENT

12. On September 17, 2013, U.S. Patent No. 8,537,279 entitled "Digital Microform Imaging Apparatus" was duly and legally issued by the United States Patent and Trademark Office. A copy of the '279 Patent is attached as **Exhibit A**.

13. e-Image is the owner by assignment of the entire right, title, and interest in the '279 Patent.

14. The '279 Patent relates to an integrated desktop microform reader designed for public use. The claimed invention is used primarily by libraries, universities, and researchers to quickly convert microfilm or other images to electronic images for editing, printing, e-mailing, or saving to other media

15. By making, using, selling, and offering to sell the ViewScan Products, ST Imaging has infringed and continues to infringe numerous claims of the '279 Patent including at least claim 44.

16. On November 3, 2015, U.S. Patent No. 9,179,019 entitled "Digital Microform Imaging Apparatus" was duly and legally issued by the United States Patent and Trademark Office. A copy of the '019 Patent is attached as **Exhibit B**.

17. e-Image is the owner by assignment of the entire right, title, and interest in the '019 Patent.

18. The '019 Patent relates to an integrated desktop microform reader designed for public use. The claimed invention is used primarily by libraries, universities, and researchers to

quickly convert microfilm or other images to electronic images for editing, printing, e-mailing, or saving to other media.

19. By making, using, selling, and offering to sell the ViewScan Products, ST Imaging has infringed and continues to infringe numerous claims of the '019 Patent including at least claims 1–3, 5–11, 13–24, 27–35, 37, 39–41, 43, 44, 47, 53–57, 63–70, 79, 81, 84–87, 91–96, and 101.

20. On November 24, 2015, U.S. Patent No. 9,197,766 entitled “Digital Microform Imaging Apparatus” was duly and legally issued by the United States Patent and Trademark Office. A copy of the '766 Patent is attached as **Exhibit C**.

21. e-Image is the owner by assignment of the entire right, title, and interest in the '766 Patent.

22. The '766 Patent relates to an integrated desktop microform reader designed for public use. The claimed invention is used primarily by libraries, universities, and researchers to quickly convert microfilm or other images to electronic images for editing, printing, e-mailing, or saving to other media.

23. By making, using, selling, and offering to sell the ViewScan Products, ST Imaging has infringed and continues to infringe numerous claims of the '766 Patent including at least claims 41–43, 46, 49, 53, and 54.

Count One
INFRINGEMENT OF U.S. PATENT NO. 8,537,279

24. e-Image incorporates and realleges by reference as if fully set forth herein the allegations contained in paragraphs 1 through 23.

25. ST Imaging has infringed and continues to infringe, directly or indirectly, one or more claims of the '279 Patent, either literally or under the doctrine of equivalents, by making,

using, selling, and offering for sale in the United States, or importing into the United States, microfilm scanners, including the ViewScan Products.

26. By making, using, offering for sale, selling, or importing into the United States the ViewScan Products, ST Imaging has infringed and continues to infringe, either literally or under the doctrine of equivalents, numerous claims of the '279 Patent including at least claim 44.

27. Attached as **Exhibit D** is an exemplary claim chart identifying where each element of claim 44 is found in the ViewScan Products.

28. Upon information and belief, ST Imaging's infringement has been intentional, willful, and in reckless disregard of e-Image's rights.

29. Upon information and belief, ST Imaging has been aware of the application that became the '279 since at least November 22, 2012, the publication date of U.S. Patent Application Publication No. 2012/0293845.

30. ST Imaging's infringement damaged and continues to damage e-Image in an amount to be determined at trial.

31. ST Imaging's infringement has caused, and unless enjoined by this Court under 35 U.S.C. § 283, will continue to cause e-Image to suffer irreparable harm for which it cannot be adequately compensated by a monetary award.

Count Two
INFRINGEMENT OF U.S. PATENT NO. 9,179,019

32. e-Image incorporates and realleges by reference as if fully set forth herein the allegations contained in paragraphs 1 through 31.

33. ST Imaging has infringed and continues to infringe, directly or indirectly, one or more claims of the '019 Patent, either literally or under the doctrine of equivalents, by making,

using, selling, and offering for sale in the United States, or importing into the United States, microfilm scanners, including the ViewScan Products.

34. By making, using, offering for sale, selling, or importing into the United States the ViewScan Products, ST Imaging has infringed and continues to infringe, either literally or under the doctrine of equivalents, numerous claims of the '019 Patent including at least claims 1–3, 5–11, 13–24, 27–35, 37, 39–41, 43, 44, 47, 53–57, 63–70, 79, 81, 84–87, 91–96, and 101.

35. Attached as **Exhibit E** is an exemplary claim chart identifying where each element of claims 1–3, 5–11, 13–24, 27–35, 37, 39–41, 43, 44, 47, 53–57, 63–70, 79, 81, 84–87, 91–96, and 101 is found in the ViewScan Products.

36. Upon information and belief, ST Imaging has been aware of the application that became the '019 Patent since at least January 16, 2014, the publication date of U.S. Patent Application Publication No. 2014/0015958.

37. ST Imaging's infringement damaged and continues to damage e-Image in an amount to be determined at trial.

38. ST Imaging's infringement has caused, and unless enjoined by this Court under 35 U.S.C. § 283, will continue to cause e-Image to suffer irreparable harm for which it cannot be adequately compensated by a monetary award.

Count Three
INFRINGEMENT OF U.S. PATENT NO. 9,197,766

39. e-Image incorporates and realleges by reference as if fully set forth herein the allegations contained in paragraphs 1 through 38.

40. ST Imaging has infringed and continues to infringe, directly or indirectly, one or more claims of the '766 Patent, either literally or under the doctrine of equivalents, by making,

using, selling, and offering for sale in the United States, or importing into the United States, microfilm scanners, including the ViewScan Products.

41. By making, using, offering for sale, selling, or importing into the United States the ViewScan Products, ST Imaging has infringed and continues to infringe, either literally or under the doctrine of equivalents, numerous claims of the '766 Patent including at least claims 41–43, 46, 49, 53, and 54.

42. Attached as **Exhibit F** is an exemplary claim chart identifying where each element of claims 41–43, 46, 49, 53, and 54 is found in the ViewScan Products.

43. Upon information and belief, ST Imaging has been aware of the application that became the '766 Patent since at least January 8, 2015, the publication date of U.S. Patent Application Publication No. 2015/0009317.

44. ST Imaging's infringement damaged and continues to damage e-Image in an amount to be determined at trial.

45. ST Imaging's infringement has caused, and unless enjoined by this Court under 35 U.S.C. § 283, will continue to cause e-Image to suffer irreparable harm for which it cannot be adequately compensated by a monetary award.

WHEREFORE, Plaintiff e-ImageData Corporation respectfully requests judgment and relief against Digital Check Corp. doing business as ST Imaging as follows:

A. A declaration that ST Imaging has infringed the '279 Patent in violation of 35 U.S.C. § 271;

B. An injunction under 35 U.S.C. § 283 that temporarily and permanently enjoins ST Imaging, including its officers, agents, employees, and representatives, and those acting in

privity and/or concert therewith, from further infringement of the '279 Patent for the full term thereof;

C. An award of damages to e-Image under 35 U.S.C. § 284 that is adequate to compensate for ST Imaging's infringement of the '279 Patent, but in no event less than a reasonable royalty for the use made by ST Imaging of e-Image's invention, and that is trebled, together with pre- and post-judgment interest and costs;

D. An award of provisional rights damages to e-Image under 35 U.S.C. 154(d) that is no less than a reasonable royalty for the period beginning on the date of publication of the application that became the '279 Patent and ending on the date the '279 Patent issued.

E. A declaration that ST Imaging has infringed the '019 Patent in violation of 35 U.S.C. § 271;

F. An injunction under 35 U.S.C. § 283 that temporarily and permanently enjoins ST Imaging, including its officers, agents, employees, and representatives, and those acting in privity and/or concert therewith, from further infringement of the '019 Patent for the full term thereof;

G. An award of damages to e-Image under 35 U.S.C. § 284 that is adequate to compensate for ST Imaging's infringement of the '019 Patent, but in no event less than a reasonable royalty for the use made by ST Imaging of e-Image's invention, together with pre- and post-judgment interest and costs;

H. An award of provisional rights damages to e-Image under 35 U.S.C. 154(d) that is no less than a reasonable royalty for the period beginning on the date of publication of the application that became the '019 Patent and ending on the date the '019 Patent issued.

I. A declaration that this case is exceptional and an award of attorneys' fees, disbursements, and costs to e-Image under 35 U.S.C. § 285;

J. A declaration that ST Imaging has infringed the '766 Patent in violation of 35 U.S.C. § 271;

K. An injunction under 35 U.S.C. § 283 that temporarily and permanently enjoins ST Imaging, including its officers, agents, employees, and representatives, and those acting in privity and/or concert therewith, from further infringement of the '766 Patent for the full term thereof;

L. An award of damages to e-Image under 35 U.S.C. § 284 that is adequate to compensate for ST Imaging's infringement of the '766 Patent, but in no event less than a reasonable royalty for the use made by ST Imaging of e-Image's invention, together with pre- and post-judgment interest and costs;

M. An award of provisional rights damages to e-Image under 35 U.S.C. 154(d) that is no less than a reasonable royalty for the period beginning on the date of publication of the application that became the '766 Patent and ending on the date the '766 Patent issued.

N. A declaration that this case is exceptional and an award of attorneys' fees, disbursements, and costs to e-Image under 35 U.S.C. § 285; and

O. Such other and further relief as the Court deems necessary and just.

JURY DEMAND

Plaintiff demands a trial by jury on all issues properly tried to a jury.

Dated this 12th day of May, 2016.

s/Johanna M. Wilbert

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